UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,234	04/18/2001	David Klug	88265-4026	1401

28765 7590 03/20/2003

WINSTON & STRAWN
PATENT DEPARTMENT
1400 L STREET, N.W.
WASHINGTON, DC 20005-3502

EXAMINER
TRAN LIEN, THUY

ART UNIT	PAPER NUMBER
1761	17

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A2-17

Application No.	Applicant(s)
09/837,234	Klug et al.

Office Action Summary

Examiner	Art Unit
Lien Tran	1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jan. 16, 2003*.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1 and 3-23* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1 and 3-23* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

1. The 112 first rejection of claims 22-23 is maintained for the same reason set forth in paragraph 1 of the previous office action.

2. Claim 2 and 11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant amended claim 2 to recite the limitation " wherein the sugar wafer solidifies from a semi-liquid or semi solid mass that is sufficiently flowable to conform to the cone". This limitation is not supported by the original disclosure. The specification does not disclose anything about the wafer being solidifies from a semi-liquid or semi solid mass. Also, how can the wafer solidifies to conform to the cone? The wafer is already a solid mass and it is the cone. The new limitation added to claim 11 is not supported by the original disclosure for the same reason set forth for claims 22-23.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is vague and indefinite; it is not known what applicant is trying to claim. How can the wafer solidifies from a semi-liquid or semi-solid mass when it is already a solid substance and how can the wafer conform to the cone when the wafer is the cone.

4. Claims 1, 3-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conti et al for the same reason set forth in paragraph 3 of the previous office action.

Conti et al disclose sugar wafers. The wafers may have a variety of shapes and sizes e.g. they may be flat sheets, cup, cone-shaped, or tubular. They may be used in a variety of confectionery products together with confectionery materials such as chocolates or other fatty material such as fat-based cream. A moisture barrier may be used between the surface of the sugar wafer and the other confectionery material; the barrier is preferably chocolate or chocolate substitute. The confectionery material preferably has a low water activity of below .3. Example 1 discloses the wafer tube is filled with a fat-based cream containing yoghurt. The wafer product may be enrobed with another suitable confectionery material such as plain, white or milk chocolate or with chocolate substitute. (See pages 4-5)

Conti et al do not disclose the size, the step of allowing the confectionery to harden, the inclusion of edible inclusions, the amount of vegetable fat in combination with chocolate and the material being solid under ambient temperature..

Conti et al disclose confectionery materials such as chocolates or other fatty material such as fat-based cream are used to fill the sugar wafer. Chocolate is the same confectionery material used in the claimed product and process, thus, it is obvious the confectionery material has the same characteristic as claimed. It is known chocolate is solid under ambient temperature. It would have been obvious to use a combination of chocolate with other fat depending on the taste desired. If the taste of such fat is wanted, it would have been obvious to add the fat and the

amount can vary depending on the content of the fat desired. The filling material can be chocolate or fat-based cream which can be made to be molten or solid by changing the temperature and thus, the state of the filling material depends on the taste and flavor desired. It would have been obvious to allow the confectionery material to harden if a solid mass is desired. For example, if one desires the taste of a solid mass, it would have been obvious to allow the confectionery material to harden or if one wants the taste of a liquid confectionery material, it would have been obvious to do the opposite. It would have been obvious to make the product in any size because Conti et al teach the sugar wafers may have a variety of sizes. It would also have been obvious to add edible inclusions to give extra taste and flavor. As to allowing the confectionery material to take the shape of the wafer, it would have been obvious to one skilled in the art to adjust parameters, such as viscosity, temperature at which the material is filled into the wafer, the amount of filling material and the shape of the wafer, to allow the filling material to take the shape of the wafer when such design is wanted. It would also have been obvious to make the confectionery material to have a dome shape to give the look of an ice cream to enhance the novelty of the product since Conti et al disclose the wafer may have a cone-shape and cone shape wafer is commonly associated with ice cream.

5. In the response filed Jan. 16, 2003, applicant traverses the new matter rejection. Applicant argues a flowable material will harden or solidify in place after it fills the sugar wafer. The examiner did not question the fact that the flowable material will harden or solidify; that portion of the claim is supported by the original disclosure. The questionable limitation is " a

portion of the mass flows to conform to the shape of the sugar wafer"; there is no disclosure at all about a portion of the mass flowing to conform to the shape of the sugar wafer. Applicant argues a molten material is flowable and the claimed limitation is inherent or explicitly supported in the spirit of the specification. The claimed limitation is not inherent in the disclosure. A molten material will not necessarily flow to conform to a specific shape. For instance, a material might be molten but have a high viscosity and thus might not flow to fill a specific shape. Furthermore, the shape of the product also defines if the material will flow to conform to the shape. If a liquid material is poured onto a flat shape, the material will not flow to conform to the shape. The use of the term " molten" in the specification does not provide supported for what is being claimed. Applicant has not demonstrate that all molten material will flow to conform to a shape. Applicant states the burden is on the office to demonstrate lack of possession of the invention in the claim terms. The examiner is not aware of this requirement. It is a question of support in the original specification; the specification either discloses it or it does not. In the instant situation, applicant has not pointed out the portion of the specification that would support such limitation. With respect to the limitation in claim 22, applicant argues no special temperature is recited in connection with this hardening of the filling and thus the conventional understanding is that this hardening occurs under ambient temperature and other ambient conditions. This argument is without support. Applicant has not shown that confectionery material only hardens under ambient temperature. The fact that the specification does not disclose any temperature is a clear

evidence that the limitation is not supported by the original disclosure. Claims 22-23 are fully considered as set forth above in the rejection.

With respect to the 103 rejection, applicant argues Conti et al teach away from several recited feature because yogurt is well known to contain water while the claims recite a substantially water-free material. This argument is not persuasive because Conti discloses a variety of filling materials including chocolates or other fatty materials such as fat-based cream which are the same as some of the filling materials claimed. Furthermore, Conti et al do not disclose yogurt as the filling material; they disclose fat based creams containing yoghurt. Applicant states Conti et al acknowledge the problem of using conventional water-based confectionery fillings by stating that it is preferably to minimize moisture migration problem; this acknowledgment is applicant's own speculation because Conti et al do not disclose just water-based confectionery filling. They also disclose chocolates or fat-based cream. The use of a moisture barrier is optional and depends on the filling material used. Furthermore, it would have been an obvious matter of choice to add any type of filling material depending on the taste and flavor desired. As to the solidification in the wafer, this depends on the type of filling material wanted. If a solid mass of chocolate is desired, it would have been obvious to allow the chocolate to harden. Applicant argues the disclosure of yogurt or fat-based creams are expected to remain fluid/flowable. Conti et al do not disclose yogurt; they disclosed fat-based creams containing yogurt. The fluidity or flowability of the fat-based creams depends on the type of creams. The creams as normally used in sandwich cookie or wafer cookies are not fluid. It is again stressed

that it would have been an obvious matter of preference to use any type of filling materials. Applicant argues the rejection is based on hindsight. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, Conti et al clearly teach the filling materials can be a variety of ingredients including substantially water-free based confectionery materials such as chocolates and fat-based cream. Applicant keeps referring to the material in Conti as yogurt and it is clearly not the case. All the limitations of the dependent claims are addressed in the rejection and are not deemed to be patentably distinct over the prior art. The examiner is well aware of the product and process claimed in the application. It is the examiner's position that both the product and process are obvious in view of the teaching of Conti et al.

6. Applicant's arguments filed Jan. 16, 2003 have been fully considered but they are not persuasive.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien Tran whose telephone number is 703-308-1868. The examiner can normally be reached on Wed-Fri. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

March 19, 2003

Lien Tran

LIEN TRAN
PRIMARY EXAMINER
Group 1702